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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 958

H. C. BAXTER & BRO. and GENERAL FOODS CORPORATION,

Petitioners,

v.

THE GREAT ATLANTIC & PACIFIC TEA COMPANY, INC.,

Respondent.

BRIEF IN OPPOSITION

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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THE GREAT ATLANTIC & PACIFIC TEA COMPANY, INC.,

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

BRIEF IN OPPOSITION

This brief is submitted by respondent in opposition to the petition, dated January 27, 1966, praying that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit which was entered in the above-entitled action on October 29, 1965. It is important to observe at the outset that the petition, which is exceedingly sparse in its references to the record, has largely distorted the evidence presented at the trial in an effort to lend some substance to petitioners' position. The petition is replete with statements of fact and law which not only are entirely unsupported by any references to the record or citations of authority, as the case may be,

but which, in many instances, are completely at variance with the facts shown by the evidence or with the prevailing law.[1] The petition represents, in essence, an attempt by petitioners to free themselves from the findings of fact which were made by the District Court and accepted by the Court of Appeals in its *per curiam* opinion.

Questions Presented

Petitioners, at page 2 of their petition, have set forth two questions, identified as "Question 1" and "Question 2", respectively, which they contend are presented for review by "the case", which term they seek to divorce from the decisions of the two courts below (Petition, p. 7) without further definition of such term.

At page 7 of their petition, petitioners concede that neither of the two courts below decided or considered Question 1. This question was never raised by petitioners before their petition was filed. Furthermore, the question of whether discoveries "made by accident or diligent trial and error are as patentable as those made by inspiration or intelligence" (Petition, p. 9) has never been an issue in this case. Indeed, this is the first time that petitioners have characterized the purported invention as "a discovery * * * made by accident" (Petition, p. 10) or asserted any applicability of the last sentence of 35 U.S.C. § 103. Thus, petitioners are now attempting to present to this Court for adjudication issues which were not presented to either of the two courts below. Petitioners' endeavor to present these undecided issues to this Court for determination, without the benefit of consideration by either of the

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[1] In the entire petition, there are only three record references to the evidence, two to the patent in suit (PR. 323-325) (Petition, pp. 2, 4), and another to the stipulation which describes the process employed by respondent in the manufacture of frozen French fried potatoes (PR. 335-344) (Petition, p. 3).

two courts below, is improper and an imposition on this Court.

Moreover, there is no factual foundation whatsoever in the record for Question 1. There is no finding by the District Court that the patentee had made either an "adaptation of an old process to a new use" or a "discovery of a new, useful, and unpredictable result" in such adaptation. On the contrary, as will be demonstrated below, the District Court specifically found that the process described and claimed in the patent in suit did not produce the result described in the patent by the means specified in the patent, i.e., that it did not produce uniformity of color in potatoes of varying sugar content by the use of a single sugar dip (PR. 17).[2]

Thus, Question 1 is based upon an assumption of facts which are directly contrary to those actually found by the District Court on this issue. The facts incorporated by petitioners in this question simply do not exist. Question 1 is an attempt to present this case in a light not presented to or considered by either of the two courts below and not supported by the record. However interesting the question might be when presented by a record, it is not properly justiciable on the record herein.

At page 2 of their petition, after setting forth Question 2, petitioners state:

> "The quoted statement in 'Question 2' is the entire ruling of law of the Court of Appeals for the First Circuit in disposing of this case. We have quoted it *verbatim* from the Opinion below (App. B 20-21) * * *."

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[2] "PR." denotes references to the "Record Appendix to Brief for Appellants" in the Court of Appeals. "RR." denotes references to the "Record Appendix to Brief of Appellee" in the Court of Appeals. "P. Ex." denotes references to plaintiffs' exhibits. "D. Ex." denotes references to defendant's exhibits.

However, a comparison of the quoted statement in Question 2 with the opinion of the Court of Appeals reveals that not only have petitioners *not* quoted the opinion of that Court "verbatim", but that, indeed, they have changed the language of that Court by substituting the word "understand" for the word "ascertain". Having thus misquoted the opinion of the Court of Appeals, petitioners then proceed to argue upon the basis of the misquoted language.

As formulated by petitioners, Question 2 is stated in such a biased and argumentative manner as to obscure the only issue which may properly be presented. Stated in a more restrained and accurate fashion, the question is as follows:

Question 2. Was the Court of Appeals correct in concluding that the evidence supported the District Court's holding that Claims 1, 6 and 7, of the patent in suit are invalid under 35 U.S.C. § 112 because of the extent of experimentation required of one skilled in the art in order to ascertain their "teaching"?

As to Question 2, petitioners contend that they do not understand the *per curiam* opinion of the Court of Appeals (Petition, p. 2). However, contrary to the contention made by petitioners, and as will be demonstrated below, the conclusion of the Court of Appeals is clear and easily understandable when considered in the light of the evidence and the opinion of the District Court, and it is completely compatible with the facts found by the District Court.

Statement of the Case

This is a civil action wherein petitioners charge respondent with infringement of United States Letters Patent No. 2,498,024 (P. Ex. 1, PR. 323-325), entitled "Prefrying Treatment of Potatoes", issued on February 21, 1950, to John L. Baxter of Brunswick, Maine, upon application Serial No. 689,205 filed on August 8, 1946. Petitioners rely upon only Claims 1, 6 and 7 of the patent.

The original complaint, in which only the then owner of the patent, H. C. Baxter & Bro., a partnership, was named as plaintiff, was filed on December 26, 1962. Subsequently, by an instrument dated January 7, 1963, plaintiff, H. C. Baxter & Bro., assigned to General Foods Corporation an undivided 13% interest in the patent. Thereafter, upon motion of respondent, General Foods Corporation was joined as a party plaintiff on February 14, 1964.

In their "Statement" of the case, at pages 2-3 of their petition, petitioners state that the patent "has for its object the industrial production of French fried potatoes for quick freezing". However, on the contrary, neither the specification nor the claims so indicate. None of the claims includes any freezing step, and, indeed, the claims in suit provide for immersion of the potato strips in a sugar solution of a stated concentration for a stated time, regardless of the use to be made of the fried potato strips.

Petitioners then proceed to state as follows (Petition, p. 3):

> "The industry requires these potatoes to be fried to a quite rigidly uniform color though the raw potatoes used are of varying sugar content and would therefore fry to varying colors if untreated. The patented process solves this dilemma."

The statement, "The patented process solves this dilemma.", is completely contrary to the facts shown by the evidence and found by the District Court. As the evidence discussed in the District Court's opinion demonstrated (PR. 17-22, 26-29), and as that Court found (PR. 17), the process described in the patent did *not* solve this dilemma, because the use of a single sugar dip, under the conditions provided for in the patent, did not produce color uniformity in potatoes of varying sugar content (PR. 17). The operative findings of fact of the District Court on this issue are

succinctly summarized in the following paragraph of its opinion (PR. 17):

> "The evidence thus plainly shows that, as defendant asserts and plaintiffs concede, the sole feature of novelty in Baxter's claimed invention was the use of a single sugar dip to obtain color uniformity in potatoes of varying sugar content. The serious question raised by defendant is whether the process as described by Baxter in his patent is effective to accomplish this result. Upon the record before it, the Court must conclude that it is not, both because the process described in the patent does not effect leaching at all, or at least over substantially the entire range of concentrations and immersion times specified in the claims, and because the patent includes sugars which are inoperative to attain the claimed result under the conditions of use which the claims set forth."

In the face of the evidence discussed by the District Court and these specific findings of that Court, petitioners, in arguing that color uniformity in potatoes of varying sugar content is achieved by the means specified in the patent, are simply asking this Court to overturn the findings of fact which were made by the District Court after full trial and careful consideration of the evidence.

The process employed by respondent in the manufacture of frozen French fried potatoes is described in the stipulation (P. Ex. 8, PR. 335-343), as amended at the trial (RR. 35-36), and further in the testimony of Roy Gibson (PR. 108-134). It includes, among other steps, an initial blanch or partial cooking of the raw potato strips in two blanchers which contain plain hot water, and then a passage of the potato strips through an "S"-shaped flume, where they are immersed for 5 to 7 seconds in a 2% solution of dextrose which has a temperature of 160° F. (P. Ex. 8, PR. 338). Additional details of respondent's process are set forth in the opinion of the District Court (PR.

13). In this connection, it should be observed that the initial hot water blanch of respondent's process is not a step of the process defined in the claims of the patent in suit.

In its affirmative defenses, which are set forth at length in Paragraphs 8 to 10, inclusive, of its "Amended Answer and Counterclaim", and in its "Amendment of Defendant's Amended Answer and Counterclaim", dated March 17, 1964, respondent averred in substance that the patent in suit was invalid upon the grounds, among others, of inoperativeness (Paragraph 8.H.) and indefiniteness (Paragraph 8.I.), and that, even if the patent in suit were valid, respondent had not infringed the same.

After eleven days of trial and one day of oral argument, the District Court rendered a written opinion on December 10, 1964, holding that Claims 1, 6 and 7, of the patent in suit were invalid, and directing, among other things, that judgment be entered dismissing the complaint (PR. 5-31). Because, in the view of the District Court, the evidence compelled the conclusion that the claims in suit were invalid upon the grounds of inoperativeness and indefiniteness, which conclusion it considered dispositive of the action, that Court found no occasion to consider whether the patent was invalid upon any of the other grounds advanced by respondent, including prior knowledge and use, prior public use, and lack of invention (PR. 14), and also found it unnecessary to reach the questions raised as to infringement (PR. 13-14). Final judgment in accordance with the opinion was entered on December 18, 1964 (PR. 31-32).

On January 15, 1965, petitioners appealed to the Court of Appeals for the First Circuit from the judgment of the District Court entered on December 18, 1964 (PR. 33). In the Court of Appeals, petitioners sought a review not only of the issues which the District Court had decided, but also attempted to present to that Court for determina-

tion those issues in respect of validity and infringement which the District Court had neither decided nor considered. The Court of Appeals, however, affirmed the judgment of the District Court with a *per curiam* opinion rendered on October 29, 1965, upon which judgment was entered on the same date. The petition to this Court for a writ of certiorari followed.

At page 3 of their petition, referring to respondent's defense of indefiniteness under 35 U.S.C. § 112, petitioners state:

> "It was this last defense that seems to have been upheld by the District Court by its judgment (App. B 22) and opinion (App. B 24-50). No decision was made by the District Court as to the other alleged grounds of invalidity or on the issue of infringement."

It should be observed, however, that the District Court found that "the patent teaches results which are unobtainable" (PR. 22), and held that, "Under such circumstances, the patent and all of its claims are invalid for inoperativeness" under 35 U.S.C. § 101 (PR. 22-23). Nowhere in their petition do petitioners mention, let alone discuss, this finding and holding of the District Court.

Petitioners also state at page 7 of their petition:

> "More particularly, it is plain from the trial court's summary of the proven facts that there was no experimentation in the *practice* of the patented process, but only in the selection of the potatoes to be processed. It was the potato buyer and not the potato cook who did the experimenting."

It is submitted that nothing could be further from the truth. It is clear from the sentence in the petition which immediately precedes the quoted language (pp. 6-7) that petitioners have conveniently chosen to refer to only a small segment of the District Court's summary of the proven

facts (PR. 9-13). When the large and significant remainder of the District Court summary of the proven facts (PR. 17-22, 26-29) is considered, it becomes plain that the experimentation referred to by the District Court is in the *practice* of the process described in the patent, and not in the selection of the potatoes to be processed.

The opinion of the District Court constituting its findings and conclusions represents an unusually complete, meticulous and painstaking, consideration by the District Court of all of the evidence which was presented by each party at the trial on the several issues which that Court regarded as compelling a holding of invalidity apart from the other issues which were raised relative to validity and infringement. It is noteworthy that nowhere in the petition do petitioners contend that the District Court ignored any evidence or erroneously found any facts.

Petitioners, while thus paying lip service to the findings and asserting that they are challenging only the two lower courts' understanding of the applicable law (Petition, pp. 11-12), nevertheless proceed in their petition (pp. 10, 13-15) to attack the results which are clearly evident from Professor Ora Smith's experimental work, ignoring the admissions of their own expert, Saunders, to the same effect. The attack is thus, in effect, a challenge of the findings of fact which were made by the District Court after careful consideration of all of the evidence presented which was pertinent to the issues which that Court decided.

Thus, petitioners refer at page 14 of their petition to "treated potatoes of *different* original sugar content [having] the *same* color on frying after being subjected to the *same* treatment" as though it were a fact. This statement of alleged fact, as well as other similar statements in the petition (see, for example, pp. 3, 10, 13, 16), is directly contrary to the finding of the District Court that, as to whether the process described in the patent in suit

is effective to produce color uniformity in potatoes of varying sugar content,

> "Upon the record before it, the Court must conclude that it is not." (PR. 17)

Summary of Argument

1. The question of "the manner in which the invention was made" (Petition, p. 10) has nothing to do with Question 1 as that question is set forth at page 2 of the petition. These are two separate and distinct questions. Both of these questions will be considered herein.

2. The question of "the manner in which the invention was made" has never been an issue in this case. Respondent has never challenged the validity of the patent in suit because of the manner in which the purported discovery thereof was made. The question of whether discoveries "made by accident or diligent trial and error are as patentable as those made by inspiration or intelligence" (Petition, p. 9) was not presented to either of the two courts below for determination, and neither of those courts even considered the question, either directly or indirectly. Indeed, respondent has never contended, in any of the proceedings heretofore had herein, that discoveries "made by accident or diligent trial and error" are not as patentable as those "made by inspiration or intelligence". Nor have petitioners ever asserted any applicability of the last sentence of 35 U.S.C. § 103 in any of the prior proceedings. Thus, at this late stage, petitioners have created an artificial issue, which was neither raised in nor decided or considered by either of the two courts below, and are endeavoring to present such issue to this Court for determination in the first instance. This is improper and an imposition on this Court.

3. Question 1, as set forth at page 2 of the petition, presupposes (1) that the patentee had made an "adaptation of an old process to a new use" and (2) that the patentee had made a "discovery of a new, useful and unpredictable result" in such adaptation. However, the District Court did not find either of these facts. On the contrary, the District Court specifically found that the process described and claimed in the patent in suit did not produce the result asserted for it by the means specified in the patent, i.e., that the use of a single sugar dip did not produce uniformity of color in potatoes of varying sugar content. The District Court therefore concluded that, "Under such circumstances, the patent and all of its claims are invalid for inoperativeness" under 35 U.S.C. § 101 (PR. 22-23). Thus, Question 1, which presupposes that the patentee had made a "discovery of a new, useful, and unpredictable result", not only assumes the existence of facts which were not found by the District Court, but, indeed, it assumes facts which are directly contrary to those actually found by the District Court. It is thus evident that petitioners, under the pretense of presenting a question of law for determination, are in reality challenging the findings of fact of the District Court. Question 1 has no factual foundation whatsoever in the record to give it any support, and, as presented by petitioners, is nothing more than an abstract hypothetical question, without any relation to the facts established by the evidence. Therefore, Question 1 is not a proper question for decision in this case.

4. When the rulings of the two courts below are considered in the light of the evidence and the facts found by the District Court, it becomes clear that, contrary to petitioners' contention, those courts not only understood the pertinent statute, i.e., 35 U.S.C. § 112, but that they correctly applied the statute to the found facts.

5. Although petitioners are ostensibly challenging only the understanding and application of 35 U.S.C. § 112 by the lower courts, it is again plain that in reality they are attacking the findings of fact which were made by the District Court after careful consideration of all of the evidence which was pertinent to this issue (PR. 17-22, 26-29). In this connection, Rule 52(a) of the Federal Rules of Civil Procedure provides that "[f]indings of fact shall not be set aside unless clearly erroneous". The Court of Appeals reviewed such evidence and found it sufficient to support the District Court's holding that Claims 1, 6 and 7, of the patent are invalid under 35 U.S.C. § 112, "because of the extent of experimentation required of one skilled in the art in order to ascertain their 'teaching' ". Simply stated, the quoted language from the *per curiam* opinion of the Court of Appeals means that, by reason of the finding of the District Court that at best no leaching occurs except possibly "with a .25% dextrose solution at the extreme limits of the patent claims" (PR. 21, 23-24) and the complete lack of any indication in the specification or claims of the special conditions under which any leaching might take place, there is total absence of the definiteness and teaching required by 35 U.S.C. § 112.

6. The patent in suit does not meet any of the requirements of Section 112. At best, petitioners' evidence shows only that leaching may occur only with a dextrose solution of .25% concentration, and even then only under certain special conditions. The specification of the patent does not teach that leaching may occur only with a .25% dextrose solution, and, further, does not disclose any such special conditions. Neither are the claims limited to a solution having a concentration of only .25%, but are directed to a wide range of concentrations. Consequently, such limitation and such special conditions would not be apparent to one skilled in the art, and could only be ascertained by the person attempting to use the process by experimentation.

The patent is also completely silent in respect of other important facts and leaves the determination thereof to further experimentation by others. The necessity for such experimentation invalidates the patent. Under such circumstances, the patent is invalid because the disclosure thereof is too vague and indefinite.

7. The claims do not specify that the solution is intended to perform any leaching (extracting) of sugar. However, even if the claims should be construed to provide for leaching, they are indefinite and misleading for the same reasons as the specification. None of the claims contains any limitation that leaching may occur only with a .25% dextrose solution, and even then only under certain special conditions, and, consequently, such limitation can only be determined by independent experimentation. Claims are invalid when they are vague and indefinite and compel experimentation by others in order to ascertain their bounds or limits.

8. The patent in suit does not contain a single example in which specific values and conditions are set forth as an illustration of "the best mode contemplated by the inventor of carrying out his invention", as required by 35 U.S.C. § 112. The patent is at best only an invitation to experiment.

9. In the prosecution of the application in the Patent Office, the patentee admitted that the prior art showed that it was old to leach sugar out of a potato by hot water blanching, but contended "that it is patentable invention to add sugar to potatoes to secure their desired color when cooked by frying" (D. Ex. 1, RR. 159). The documentary and deposition prior art relied upon by respondent here eliminates any basis for such a contention (D. Ex. 2, RR. 324-328, 329-348; D. Exs. 36-48, inclusive, PR. 443-456, RR. 429-494). Such prior art, none of which was cited or considered by the Patent Office, unequivocally shows

that the addition of sugar to potatoes to secure the desired color when cooked by frying was well known in the art long prior to the earliest date claimed by the patentee. Thus, the basis upon which the patentee's attorneys distinguished the prior art cited in the Patent Office is absent here, and the presumption of validity which attached to the grant of the patent is dissipated. Furthermore, Claims 1 and 6 (and dependent Claim 7) provide for the employment of "a solution of a sugar that may be *absorbed* by the particles", and, therefore, do not differentiate from the prior art practice of dipping potatoes in a sugar solution to add sugar and increase the color of the fried product (D. Exs. 36-48, inclusive, PR. 443-456, RR. 429-494).

10. Among the seven sugars which are specifically named in the specification as useful to produce the desired result are sucrose and raffinose (col. 3, ls. 53-56). However, the evidence conclusively demonstrated that sucrose and raffinose are inoperative to produce the desired result unless special measures, not taught by the patent, are taken. Not a hint of these special measures is contained in the specification, and they can only be determined by independent experimentation. As was shown by the evidence, both sucrose and raffinose are ineffective to produce the desired color change under the conditions specified in the patent. This renders invalid Claims 1 and 6, which, in the light of the specification defining suitable sugars (col. 3, ls. 53-56), specifically include sucrose and raffinose in the term "a sugar". Claims to the exclusive use of a class, some of the members of which are inoperative in achieving the inventive concept, are too broad and cannot be sustained. This well-established doctrine is but a special application of the requirement of 35 U.S.C. § 112 that the invention must be described so precisely as to enable any person skilled in the art to practice it without independent experimentation. The patentee has failed to teach the art how to use what he considers to be his invention without further experimentation.

11. The District Court carefully considered all of the evidence presented by both sides (PR. 17-22, 26-29) and concluded that Claims 1, 6 and 7, of the patent in suit are invalid under 35 U.S.C. § 112 because of the extent of experimentation required of one skilled in the art in order to ascertain the conditions, *if there be any,* under which the process could be made to produce the results asserted for it. Although the Court of Appeals, in affirming this holding of the District Court, did not state the reason for its affirmance in this particular language, it is clear from the evidence and the facts found by the District Court that this is the meaning and import of the language, "because of the extent of experimentation required of one skilled in the art in order to ascertain their 'teaching' ", of which petitioners complain. When petitioners' protestation that the ruling of the Court of Appeals "is not understood by petitioners" (Petition, p. 3) is considered in the light of the evidence and the facts found by the District Court, it becomes plain that such protestation is specious and entirely devoid of any substance.

12. Statements in respect of the purported commercial success of the "patented process" appear at pages 12, 14-15 and 16, of the petition. However, the record shows that the process described and claimed in the patent in suit was found not to be satisfactory at a very early date, at least by 1952 (PR. 19; D. Ex. 50, PR. 490-492, 494-497; D. Ex. 49, PR. 459-461, 466-467, 470), and that the present commercial processes of both petitioners[3] as well as respondent embody major deviations from the process originally unsatisfactorily employed by petitioner, H. C. Baxter & Bro., and from anything disclosed in the patent.

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[3] As the District Court found, since January, 1947, petitioner, H. C. Baxter & Bro., a partnership, has produced its frozen French fried potatoes through Snow Flake Canning Company, a corporation which is wholly owned by the partnership and the individual partners (PR. 10; RR. 6-8).

Such major deviations include the subjection of the raw potato strips to an initial plain hot water blanch before they are immersed in the hot dextrose solution (D. Ex. 49, PR. 466-468, 472, RR. 498-499; D. Ex. 49-E, RR. 500-505; D. Ex. 49-F, RR. 506-507; PR. 42; D. Ex. 50, PR. 499-500, RR. 509). Thus, the commercial history of the patent in suit lends no support to petitioners' statements as to the purported commercial success of the "patented process" but rather points in the opposite direction. Furthermore, other factors which are completely unrelated to the so-called "dextrose process" have contributed to the present importance and success of frozen French fried potatoes, such as, for example, the increasing availability of means for storing frozen foods.

13. An examination of the opinions of the two lower courts reveals that there is no merit whatsoever to petitioners' argument that "the courts below found the patent invalid because the *why* [of the process] seemed to have been stated incorrectly" (Petition, p. 15). It is plain from such opinions that *actuality, not theory or supposition,* was the basis for the decisions of the courts below.

ARGUMENT

POINT I

The question of "the manner in which the invention was made" has never been an issue in this case.

At page 10 of their petition, petitioners state that whether "a discovery so made [i.e., by accident] is patentable, if new, is essentially Question 1".

It is submitted at the outset that, contrary to petitioners' assertion, the question of "the manner in which the invention was made" (Petition, p. 10) has nothing to do with Question 1 as that question is set forth at page 2 of the

petition. These are two separate and distinct questions; and it is clear from an examination of pages 8-11 of the petition that petitioners have confused one with the other. In any event, both of these questions will be considered herein.

At page 10 of their petition, petitioners state:

> "No case in which 'the manner in which the invention was made' has been an issue has heretofore reached this Court."

Even if this be so, this would not be a reason for granting the petition, for "the manner in which the invention was made" has never been an issue in this case.

At no stage of the case has respondent ever challenged the validity of the patent in suit because of the manner in which the purported discovery thereof was made. The question of whether discoveries "made by accident or diligent trial and error are as patentable as those made by inspiration or intelligence" (Petition, p. 9) was not presented to either of the two courts below for determination, and neither of those courts even considered the question, either directly or indirectly. Indeed, respondent has never contended, in any of the proceedings heretofore had herein, that discoveries "made by accident or diligent trial and error" are not as patentable as those "made by inspiration or intelligence", and petitioners have never raised this point in any of the prior proceedings. Nor has any party heretofore in this case raised any issue involving the last sentence of 35 U.S.C. § 103 which petitioners quote at page 8 of their petition and upon which their argument is apparently based.

Thus, at this late stage, petitioners have created an artificial issue, neither raised in nor decided or considered by either of the two courts below, which they are endeavoring to present to this Court for adjudication in the first in-

stance, in order to increase the apparent attractiveness of the petition, in the hope that they might thereby gain an opportunity to litigate *de novo* all of the matters which were settled by the two decisions below and to challenge indirectly the findings of fact upon which those decisions were based. Petitioners' effort to present such artificial issue to this Court for determination in the first instance is improper and an imposition on this Court.

POINT II

Question 1 is without factual foundation in the record.

Question 1, as set forth at page 2 of the petition, presupposes the existence of the following facts:

1. That the patentee had made an "adaptation of an old process to a new use"; and

2. That the patentee had made a "discovery of a new, useful, and unpredictable result" in such adaptation.

However, the District Court did not find either of these facts. On the contrary, in addition to the findings of fact which have been quoted at page 6, *supra*, to which the Court is respectfully referred at this point, the District Court found and held the following (PR. 22-23):

> "• • • Defendant's evidence, and plaintiff's own admissions, establish that these statements in the patent in respect of leaching sugar from the potato are simply untrue. Thus, the patent teaches results which are unobtainable.
>
> Under such circumstances, the patent and all of its claims are invalid for inoperativeness. A patent may be granted only on a new and 'useful' process, machine, manufacture, or composition of matter. 35 U.S.C. § 101."

As is plain from the findings of fact quoted at page 6, *supra,* and the foregoing, the District Court specifically found that the process described and claimed in the patent in suit did not produce the result asserted for it by the means specified in the patent, i.e., that the use of a single sugar dip did not produce uniformity of color in potatoes of varying sugar content. The evidence demonstrated that the process simply did not produce the "new and surprising result" which is described by petitioners at page 10 of their petition (see, *infra,* p. 20, fn. 4).

Thus, Question 1, which presupposes that the patentee had made a "discovery of a new, useful, and unpredictable result", is based upon an assumption of facts which are directly contrary to the findings actually made by the District Court on this issue. It is thus clear that petitioners, under the guise of presenting a question of law for determination, are in reality challenging the findings of fact of the District Court.

Moreover, there is no finding by the District Court that the patentee had made any "adaptation of an old process to a new use". To be sure, the patentee utilized an old process, but there was no adaptation of it to any "new use" because there is ample undisputed evidence that sugar solutions had been used long prior to 1945, the patentee's earliest claimed date, to obtain the desired color of potato strips upon French frying (D. Exs. 36-48, inclusive, PR. 443-456, RR. 429-494). Thus, the asserted adaptation to a "new use" necessarily refers to the asserted "new, useful, and unpredictable result", which the District Court found does not occur (PR. 17, 22-23).

The major premise of the patent is that immersing the potatoes in a sugar solution has an automatic combination effect of reducing the natural sugar content where it is high by leaching out sugar and supplementing the natural sugar

content where it is low by adding sugar (col. 2, ls. 16-23).[4] The specification of the patent is replete with similar statements (col. 3, ls. 36-40; col. 4, ls. 9-12, 17-21, 54-59). It was similarly presented in argument to the Patent Office (D. Ex. 1, RR. 149-150), and was apparently persuasive.

The word "leaching" as used in the patent means the extraction or removal of sugar. This was made clear at the trial by petitioners' expert, Saunders, who testified in respect thereof as follows (RR. 58):

> "Q. Well, leaching is taking out? A. Right."

That "leaching" means extraction or removal was also made clear in the reply brief which petitioners submitted to the Court of Appeals.

> "In the process described in the patent, the cold potato slices are heated by the hot solution and remain in the hot solution long enough to heat up the surface layers of the pieces and also to equalize the sugar content of the surface layers by *extracting* sugar from the pieces high in sugar and adding sugar to the pieces low in sugar. * * *" ("Reply Brief for Appellants", p. 21) [Emphasis supplied]

In the file history of the patent in the United States Patent Office (D. Ex. 1, RR. 131-165), both the Examiner and the patentee use "leaching" to mean extraction or removal of sugar. See, for example, the following language from the patentee's "Remarks" which accompanied the amendment filed July 5, 1949 (D. Ex. 1, RR. 159):

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[4] Petitioners were below (PR. 14) and are here in agreement that this is the critical concept of the patent. At page 10 of the petition it is stated by petitioners:

> "* * * the process would produce a new and surprising result—namely, that a dilute sugar solution bath may proyide a simultaneous treatment applicable to potato pieces of varying sugar content and hence of varying fry color so that upon simultaneous frying all the pieces will have substantially the same color."

> "Leaching a white potato must be done with hot water and if carried on for a sufficient length of time, a substantial percentage of the sugar can eventually be *taken out* even from the inside of a one-half inch cross section cut." [Emphasis supplied]

The patent teaches that in order to leach, the sugar solution must be hot (col. 4, ls. 6-12). However, it was shown by the evidence that no leaching takes place when the sugar solution is at a temperature of about 140° F. and higher under a broad range of concentrations and immersion times within those specified in the claims. The evidence which was presented by both sides on the issue of whether leaching would occur under the conditions taught by the patent was discussed extensively by the District Court in accurate and minute detail in its opinion (PR. 17-22). The District Court found that the statements in the patent in respect of leaching sugar from a potato, when considered in the light of the evidence, "are simply untrue" (PR. 22).

The District Court carefully considered all of the evidence which was presented by petitioners at the trial in support of the proposition that a hot sugar solution would leach natural sugars from potato strips to effect equalization of the sugar in the surface cells of the strips, which petitioners contended below and contend here occurs, and found such evidence unconvincing and insufficient to substantiate the proposition for which it was offered (PR. 20-21). The District Court's exact finding is as follows (PR. 21):

> "Thus, by plaintiffs' own admissions no leaching is obtained using a dextrose solution at .5% and higher. At best plaintiffs' evidence shows that leaching occurs only with a .25% dextrose solution at the extreme limits of the patent claims, and even then plaintiffs have adduced no evidence that a solution having the minimum sugar content under these conditions is effective simultaneously to add sugar to low sugar content pota-

toes and to produce the equalizing effect which the patent claims.[17] ''

"[17] Saunders testified that it was 'questionable' that a .25% dextrose blanch would be effective to increase the sugar content of medium low potatoes so as to achieve uniformity in a batch of medium low, medium and medium high potatoes."

Consequently, the situation herein is one in which the District Court carefully considered all of the evidence which was presented by both sides (PR. 17-22) and found as a fact that the use of a single sugar dip did not produce uniformity of color in potatoes of varying sugar content

> ''because the process described in the patent does not effect leaching at all, or at least over substantially the entire range of concentrations and immersion times specified in the claims.'' (PR. 17)

Thus, the specification of the patent asserts and teaches effects and results which cannot be obtained. Its false assertions completely mislead those who refer to it. Under such circumstances, as the District Court held, ''the patent and all of its claims are invalid for inoperativeness'' under 35 U.S.C. § 101.

The alleged ''new, useful, and unpredictable result'', which is postulated in and forms the core of Question 1, has been found by the District Court to be non-existent (PR. 17). Thus, Question 1 not only assumes the existence of facts which were not found by the District Court, but, indeed, it assumes facts which are directly contrary to those actually found by the District Court. The question has no factual foundation whatsoever in the record to give it any support. As presented by petitioners, Question 1 is nothing more than an abstract hypothetical question, without any relation to the facts established by the evidence, and indirectly an attempted challenge to the findings of fact of the District Court. Therefore, it is not a proper question for decision in this case.

POINT III

The Court of Appeals correctly concluded that the evidence supported the District Court's holding that Claims 1, 6 and 7, of the patent in suit are invalid under 35 U.S.C. § 112, because of the extent of experimentation required of one skilled in the art in order to ascertain their "teaching".

Petitioners contend at page 11 of their petition that the opinions below reflect a "confusion and misunderstanding of the statute" on the part of both of the lower courts. It is submitted, however, that, when the rulings of the lower courts are considered in the light of the evidence and the facts found by the District Court, it becomes clear that the lower courts not only understood the pertinent statute, i.e., 35 U.S.C. § 112, but that they correctly applied the statute to the found facts.

Furthermore, although petitioners are ostensibly challenging only the understanding and application of the pertinent law by the lower courts, it is again plain from pages 10 and 13-15 of their petition that in reality they are attacking the findings of fact which were made by the District Court after careful consideration of all of the evidence which was pertinent to this issue.[5]

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[5] Rule 52(a) of the Federal Rules of Civil Procedure provides in pertinent part as follows:

> "(a) *Effect.* * * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *"

To the same effect, see *A. Belanger & Sons, Inc.* v. *United States of America, Etc.*, 275 F. 2d 372, 375, 376 (1 Cir., 1960), *D'Orsay Equipment Co., Inc.* v. *United States Rubber Company*, 302 F. 2d 777, 778 (1 Cir., 1962), and *Evans, Etc., et al.* v. *United States of America*, 319 F. 2d 751, 753, 755-756 (1 Cir., 1963).

The evidence which was considered by the District Court was discussed by it at appreciable length in its opinion (PR. 17-22, 26-29). The Court of Appeals reviewed such evidence and found it sufficient to support the District Court's holding that Claims 1, 6 and 7, of the patent are invalid under 35 U.S.C. § 112, "because of the extent of experimentation required of one skilled in the art in order to ascertain their 'teaching' ". Simply stated, the quoted language from the *per curiam* opinion of the Court of Appeals means that, by reason of the finding of the District Court that at best no leaching occurs except possibly "with a .25% dextrose solution at the extreme limits of the patent claims" (PR. 21) (see, *supra*, pp. 21-22) and the complete lack of any indication in the specification or claims of the special conditions under which any leaching might take place, there is total absence of the definiteness and teaching required by 35 U.S.C. § 112.

The opinion of the District Court clearly supports this conclusion. The District Court found and held as follows:

> "Even accepting plaintiffs' evidence that leaching may occur with a .25% dextrose solution at the maximum temperature and time of immersion specified in the patent claims, neither the patent specifications nor the claims disclose any such limitation; as a result, a person attempting to use the process could only ascertain the limitation by experimentation. The law is clear that the necessity for such experimentation invalidates the patent * * *. [PR. 23-24]
>
> * * *
>
> Consequently, even if plaintiffs' evidence is given the maximum credence to which it is entitled, the claims in suit are invalid because the disclosure of the patent is too vague and indefinite to meet the statutory requirement of precision in describing the alleged invention. [PR. 25]"

It is submitted that, when petitioners' protestation that the ruling of the Court of Appeals "is not understood by petitioners" (Petition, p. 3) is considered in the light of the evidence and the facts found by the District Court, it becomes plain that such protestation is specious and entirely devoid of any substance.

As held by the District Court and affirmed by the Court of Appeals, the patent in suit does not meet the requirements of Section 112. As the District Court found, petitioners' evidence at best shows only that leaching may occur only with a dextrose solution of .25% concentration, and even then only under certain special conditions (PR. 21, 23-24). The specification of the patent does not teach that leaching may occur only with a .25% dextrose solution, and, further, does not disclose any such special conditions. Indeed, the claims are not limited to a solution having a concentration of only .25% but are directed to a wide range of concentrations. Consequently, such limitation and such special conditions would not be apparent to one skilled in the art, and long experimentation and research would be required on the part of the person attempting to use the process in order to determine whether in some obscure corner of the patent the process could be made to produce the results asserted for it.

At page 11 of their petition, petitioners state:

> "But the 'limitation' referred to is *not* as a matter of law or logic, necessary, or said to be necessary, to be observed in the practice of the process as described in the patent or as practiced by the defendant."

It is difficult to comprehend how petitioners can make such a statement in the light of the evidence and the facts found by the District Court, and necessarily sustained by the Court of Appeals, which indicate the absolute necessity of observing such limitation if the process described in the patent is to have any chance of producing the results asserted for it. As the evidence demonstrated, and as the

District Court found, petitioners' evidence shows at best only that leaching may occur only with a .25% dextrose solution, and even then only at the maximum temperature and the maximum time of immersion specified in the claims (PR. 21, 23-24). Therefore, unless such limitation and such special conditions were observed in the practice of the process described in the patent, leaching of sugar would not occur, and, consequently, the process would not produce the result asserted for it, i.e., uniformity of color in potatoes of varying sugar content would not be achieved.

On the contrary, there is no necessity for observing such limitation in the practice of the process employed by respondent for the reason that, in respondent's process, the raw potato strips are initially blanched in two blanchers which contain plain hot water before they are immersed in the hot dextrose solution (P. Ex. 8, PR. 338). This initial hot water blanch has the effect of leaching sugar and hence accomplishing a lightening of the color of the fried potato strips (D. Ex. 1, RR. 159). The process described in the patent does not include such an initial hot water blanching step.

Furthermore, although the description of the patent refers to low sugar content and high sugar content potatoes (col. 1, ls. 12 and 21-22), there is nothing in the patent which specifies what constitutes a low sugar content or a high sugar content (RR. 22-23). Neither is there anything in the patent which indicates when "the sugar content of a potato is too high to be corrected by leaching" (col. 3, ls. 36-38) (RR. 27) or when it is capable of being corrected by leaching (col. 2, ls. 10-11). The patentee Baxter admitted, moreover, that there is nothing in the patent which teaches how any of these values may be determined, other than by experimentation (RR. 22-26, 27-28).

In addition, at column 1, lines 37-39, the patent states:

> "A control of the sugar content also inhibits rancidity in the fried products."

As testified by Professor Smith, this statement is meaningless, since there is no explanation of the manner in which the sugar content is to be adjusted (PR. 156-157). There is no indication, for example, of the point at which the sugar content would inhibit rancidity, or whether the sugar content should be increased or decreased in order to inhibit rancidity (PR. 157). The patent is completely silent in respect of these important facts and leaves the determination thereof to further experimentation by others.[6]

The necessity for all of the experimentation which is discussed above invalidates the patent. The law is well settled that, under such circumstances, the patent is invalid because the disclosure thereof is too vague and indefinite. *Wood* v. *Underhill et al.*, 46 U. S. 1, 4-5 (1847); *Tyler* v. *Boston*, 74 U. S. 327, 330 (1868); *The Incandescent Lamp Patent*, 159 U. S. 465, 474-475 (1895); *Beidler* v. *United States*, 253 U. S. 447, 453 (1920); *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 60 (1931); *Standard Brands, Inc.* v. *National Grain Yeast Corp.*, 308 U. S. 34, 38 (1939).

None of the patent claims contains any limitation as to the temperature of the solution, although the teaching of the patent is that a hot solution is required if there is to be any leaching action (col. 4, ls. 6-12).[7]

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[6] In a letter, dated July 10, 1946, from John L. Baxter, Jr., to Abbott Spear, the attorney who prepared the patent application, Baxter, Jr., stated that the idea that "the sugar dip tends to inhibit rancidity" was suggested by Dr. Albert A. Schaal of Lever Brothers (D. Ex. 31, RR. 423-425). Petitioners' expert, Saunders, confirmed that the idea came from Dr. Schaal and admitted that he, Saunders, "did not know anything about nor did [he] have any experimental evidence that dipping in dextrose would retard rancidity" (RR. 77-79).

[7] Indeed, the experiments relied upon by petitioners in their unsuccessful attempt to demonstrate that sugar may be leached from the potatoes were all conducted with sugar solutions which had been heated to very high temperatures, namely, 190° F. and 212° F. (P. Exs. 29 and 36; PR. 384, 388, 265-268, 278-282).

Furthermore, the patentee Baxter admitted, in response to questions by the District Court, at least with respect to Claim 6, that "the claim is rather poorly written" (RR. 33-34), "that there was possibly a fault in the claim" (RR. 34), and that "perhaps the claim should have pointed out that the solution is a boiling solution" (RR. 34-35). In this connection, the following language from *Application of Thomson*, 315 F. 2d 919 (C.C.P.A., 1963), is particularly pertinent (p. 922):

> "* * * A particular feature upon which an applicant predicates patentability must be recited in the claims; it is not sufficient merely to disclose it in the specification. In re Lindberg, 194 F. 2d 732, 39 CCPA 866."

To the same effect are *Seyfarth* v. *Coe*, 129 F. 2d 58, 61 (D. C. Cir., 1942), and *In re Laurent*, 186 F. 2d 741, 743 (C.C.P.A., 1951).

Moreover, Claim 6 (and dependent Claim 7) is limited to the treatment of potatoes "the natural sugar content of which is *too low* to enable the desired color change to be attained when the particles are cooked by frying" and provides for the employment of "a solution of a sugar that may be *absorbed* by the particles". Although Claim 1 may be considered to be somewhat broader than Claim 6, nevertheless, it also similarly specifies "a solution of a sugar that may be *absorbed* by the particles". Accordingly, the claims do not specify that the solution is intended to perform any leaching.

However, even if the claims should be construed to provide for leaching, they are indefinite and misleading for the same reasons as the specification. As has been pointed out above, even if petitioners' evidence were to be given the maximum credence to which it could possibly be entitled, it would still show only that leaching may occur only with a .25% dextrose solution, and even then only under certain special conditions. None of the claims con-

tains any such limitation, and, consequently, such limitation can only be determined by independent experimentation.

Claims are invalid when, as is the case here, they are vague and indefinite and compel experimentation by others in order to ascertain their bounds or limits. *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 368-369 (1938); *United Carbon Co.* v. *Binney Co.*, 317 U. S. 228, 234-237 (1942); *Standard Oil Co.* v. *Tide Water Associated Oil Co.*, 154 F. 2d 579, 582-583 (3 Cir., 1946); *Parker Appliance Co.* v. *Irvin W. Masters, Inc.*, 94 F. Supp. 72, 73-74 (S. D. Cal., 1950); *Merrill* v. *Builders Ornamental Iron Co.*, 197 F. 2d 16, 24 (10 Cir., 1952).

The patent in suit is remarkable in that it deals with the sugar concentration, the temperature of the solution and the period of immersion, only in generalities or ranges, and does not contain a single example in which specific values and conditions are set forth as an illustration of "the best mode contemplated by the inventor of carrying out his invention", as required by 35 U.S.C. § 112. At best, the patent is but an invitation to experiment.

At page 12 of their petition, petitioners state:

> "It is clear from the evidence and the opinion of the District Court that no experimentation whatsoever was required or practiced in producing the several billion pounds of frozen French fried potatoes that have been produced by the patented process since the complaint in the first suit against General Foods was filed in 1961."

This statement is inaccurate and misleading. As the evidence demonstrates, and as the District Court found,

> "In 1952 both Baxter and General Foods modified the original Baxter manufacturing process by the addition of a hot water blanching step in advance of the

hot dextrose dip * * *. * * * Baxter and General Foods have used the modified process, essentially without change, continuously since 1952." (PR. 12)

As has been shown above, the process employed by respondent since October, 1962, when its plant at Fort Fairfield, Maine, began commercial production, has always included two plain hot water blanches prior to the hot dextrose dip (P. Ex. 8, PR. 338). This initial hot water blanching step, which is included in the processes employed by both petitioners and by respondent, is not included in the process which is described in the patent in suit. Thus, contrary to the statement made by petitioners, the frozen French fried potatoes which have been produced by petitioners themselves and by respondent since 1961 have not been produced by the "patented process", but by processes which embody a major deviation from the process described in the patent. There is no evidence whatsoever in the record as to the details of the processes employed by any others who may have used a sugar solution in the production of frozen French fried potatoes since 1961.

At page 13 of their petition, petitioners state:

"* * * In selecting the potatoes to be purchased and processed, a 'fry test,' fully described in the patent in suit and in the District Court's opinion (App. B 30) is used. Only those lots of potatoes are purchased in which the highest sugar content of any tested potatoes is not excessive and the difference between the highest and lowest sugar content is not over four of the seven classifications, *viz.*, 'very low, low, medium low, medium, medium high, high, and very high,' in which the test fried potatoes are classified. * * *"

The "fry test" does not relate to or cure the vice which the two courts below found to exist in the process described in the patent. Furthermore, as in the case of the tem-

perature of the solution, the "fry test" is not an element of any of the claims, and, therefore, petitioners cannot rely upon such feature for patentability. *Application of Thomson, supra; Seyfarth* v. *Coe, supra; In re Laurent, supra.* As this Court stated in *McClain* v. *Ortmayer,* 141 U. S. 419 (1891), at pages 423-424:

> "* * * Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public. * * *"

Moreover, the statement of petitioners which has been quoted above is incomplete and misleading, since petitioners have failed to point out that the classification system described therein is used only by petitioners and not by respondent. The handwritten numbers ranging from 0 to 4 on the color chart which is attached as "Exhibit A" to the stipulation describing respondent's process (P. Ex. 8, RR. 342) indicate that respondent grades potatoes for sugar content into *eight* classifications by means of its fry test, namely, 0, ½, 1, 1½, 2, 2½, 3 and 4. In addition, the stipulation provides in pertinent part as follows (P. Ex. 8, RR. 336):

> "* * * The desired standard for color acceptability requires all fried strips to fall in the range of from 0 to 3½ on the color chart, but a color as high as 4 in not more than 10% of the fried strips may be accepted."

Gibson, manager of respondent's fresh and frozen potato operations in Maine (PR. 103-106), testified that "we must be within this zero to 3½ range" (PR. 143) and also as follows (PR. 144):

> "The Court: And on your fry test you would consider acceptable any potatoes which fell as to color

within the range from zero, which is practically white as I view it, to 3½, is that correct?

The Witness: That is correct."

Thus, respondent uses potatoes which fall into at least *seven* of the aforesaid *eight* groups, and not only four out of seven groups as utilized by petitioners.

At page 14 of their petition, petitioners state:

> "* * * until Dr. Smith's testimony in this case, it was apparently the belief of all parties to the litigation, including the General Foods personnel, that when a batch of potatoes of mixed high and low sugar content (Pat. Col. 4, lines 35-36) was dipped in a hot sugar solution of medium concentration, the resulting color of the dipped potato was, on frying, the color that the potatoes of medium sugar content would have had, if fried without dipping. * * *"

This statement is completely contrary to the facts shown by the evidence and found by the District Court, for this clearly was *not* "the belief of all parties to the litigation, including the General Foods personnel". Dr. Kenneth G. Dykstra, a research manager who joined General Foods in 1943 and who was laboratory manager of the Albion Laboratories of the Birds Eye Division of General Foods for the period of about 1947 to 1958 (D. Ex. 50, PR. 481-483), had visited the Snow Flake Canning Company (petitioner, H. C. Baxter & Bro.) plant in Corinna, Maine, sometime in 1947 and again in December, 1948, and had become familiar with and understood the single sugar dip process as it was practiced by the Baxter group at that time (D. Ex. 50, PR. 486-495). Dr. Dykstra testified that the single sugar dip process did not produce satisfactory results with potatoes which had "either a high or a variable sugar content", i.e., that it was not effective either to reduce color or to produce uniformity of color (D. Ex. 50, PR. 490-492, 494-497). He further testified that for

this reason they could not put through the single sugar dip process potatoes which had not been conditioned or stored in such a way that they had a low sugar level (D. Ex. 50, PR. 490-491), and that it was necessary to store the potatoes at a temperature of "70 or something like that, to burn these sugars down to an acceptable level", before they could be put through the single sugar dip process (D. Ex. 50, PR. 491-492). The testimony of George W. Raye, an engineer employed by General Foods since January, 1931 (D. Ex. 49, PR. 456-458), is to the same effect (D. Ex. 49, PR. 459-461, 466-467, 470). The District Court adopted the testimony of both of these witnesses (PR. 19). In the light of these facts, shown by the evidence and found by the District Court, the aforesaid statement of petitioners is plainly incorrect and unjustifiable.

At page 14 of their petition, petitioners also state that, at the time the application for the patent was prepared, the patentee and his attorney

> "believed that on dipping the potatoes in the sugar solution the solution *replaced* some of the potato juice with a resulting reduction of the sugar content of the juice of the potatoes of high sugar content and an increase of the sugar content of the low sugar potatoes, all as stated in the patent."

If, indeed, it was the belief of the patentee and his attorney at that time "that on dipping the potatoes in the sugar solution the solution *replaced* some of the potato juice", such a belief is nowhere reflected. There is nothing in the record which manifests such a belief on their part. The application for the patent (D. Ex. 1, RR. 133-144) did not speak of a *replacement* of some of the potato juice by the sugar solution, but, instead, proclaimed that the asserted result, i.e., uniformity of color in potatoes of varying sugar content, was achieved by the sugar solution's purported combination effect of *leaching* (extracting)

sugar from potatoes of high sugar content and adding sugar to potatoes of low sugar content. Similarly, in arguments which the patentee and his attorney presented to the Patent Office during the prosecuion of the application (D. Ex. 1, RR. 149-150, 153-154, 159-160), they made no reference whatsoever to any *replacement* of any of the potato juice by the sugar solution, but, instead, they explained that uniformity of color in potatoes of varying sugar content was obtained by the purported combination effect of the sugar solution in *leaching* (extracting) sugar from high sugar potatoes and adding sugar to low sugar potatoes (D. Ex. 1, RR. 149-150). Thus, as in the case of many other statements in the petition, petitioners' statement that, at the time the patent application was prepared, the patentee and his attorney "believed that on dipping the potatoes in the sugar solution the solution *replaced* some of the potato juice", is not supported by anything in the record and entirely without foundation.

In arguing during the prosecution of the patent application in the Patent Office, the patentee admitted that the prior art showed that it was old to leach sugar out of a potato by hot water blanching, but contended:

> "it is submitted that it is patentable invention to add sugar to potatoes to secure their desired color when cooked by frying." (D. Ex. 1, RR. 159; "Remarks" accompanying amendment filed July 5, 1949)

The prior art relied upon by respondent here eliminates any basis for such a contention. Documentary prior art not found by the Examiner shows that sugar content, and, more particularly, reducing sugar content, was known to be the important factor in the browning of French fried potatoes [see, for example, *Peacock,* United States Department of Agriculture Circular No. 158, March, 1931 (D. Ex. 2, RR. 324-328), and *Wright et al.,* United States Department of Agriculture Technical Bulletin No. 507, February, 1936 (D. Ex. 2, RR. 329-348)]. Depositions in evidence in

this case show in addition that long prior to 1945, the patentee's earliest asserted date, it was common knowledge in this country among chefs and produce men supplying potatoes for French frying that, when the natural sugar content of the potatoes was such that the desired browning could not be obtained upon frying, such desired browning could be attained by soaking the potato strips in a solution of sugar or glucose (dextrose) for a period of several hours or overnight (D. Exs. 36-48, inclusive, PR. 443-456, RR. 429-494). This documentary and deposition prior art is discussed in the opinion of the District Court (PR. 15-16).

In short, the prior art relied upon by respondent here, none of which was cited or considered by the Patent Office, unequivocally shows that the addition of sugar to potatoes to secure the desired color when cooked by frying was well known in the art long prior to the earliest date claimed by the patentee. Thus, the basis upon which the patentee's attorneys distinguished the prior art cited in the Patent Office is absent here, and the presumption of validity which attached to the grant of the patent is dissipated. *Royal Patent Corp.* v. *Monarch Tool & Mfg. Co.*, 203 F. 2d 299, 300 (6 Cir., 1953); *Zoomar, Inc.* v. *Paillard Products, Inc.*, 258 F. 2d 527, 530 (2 Cir., 1958); *Senco Products, Inc.* v. *Fastener Corporation*, 269 F. 2d 33, 34 (7 Cir., 1959); *Jaybee Mfg. Corp.* v. *Ajax Hardware Mfg. Corp.*, 287 F. 2d 228, 229 (9 Cir., 1961).

Furthermore, as was pointed out at page 28, *supra*, Claims 1 and 6 (and dependent Claim 7) provide for the employment of "a solution of a sugar that may be *absorbed* by the particles", and, accordingly, do not specify that the solution is intended to perform any leaching. Therefore, the claims do not differentiate from the prior art practice of dipping potatoes in a sugar solution to add sugar and increase the color of the fried product (D. Exs. 36-48, inclusive, PR. 443-456, RR. 429-494).

At page 14 of their petition, petitioners also set forth what purports to be a summary of a portion of Professor Smith's testimony. Petitioners state in part as follows:

> "* * * Dr. Smith said that the sugar solution taken up by the treated potatoes is not substituted for a like quantity of potato juice, but is *added* to the potato juice so that on frying the resulting uniform color of all of the treated potatoes would be the same as the color of potatoes of high sugar content and not potatoes of medium sugar content."

This statement is a complete distortion of Professor Smith's testimony. At no time did Professor Smith state, or even imply, that "all of the [sugar] treated potatoes" would have a "resulting uniform color" upon frying, let alone that such color "would be the same as the color of potatoes of high sugar content and not potatoes of medium sugar content". Indeed, his testimony was exactly the opposite (PR. 165-169, 171-177). Professor Smith's testimony on this issue, and the results of his supporting experimental work, were considered by the District Court and summarized in its opinion (PR. 17-19). As Professor Smith testified, and as the District Court found, the use of a single sugar dip does not produce uniformity of color in potatoes of varying sugar content, for the reason that one-half of the purported combination effect described in the patent, namely, the leaching (extraction) of sugar from potatoes of high sugar content, does not occur with a sugar solution at a temperature of about 140°F. and higher under a broad range of concentrations and immersion times within those specified in the claims (PR. 17-19, 165-169, 171-177). In addition to the testimony quoted by the District Court in its opinion (PR. 17-18), the following excerpt from the colloquy between Professor Smith and that Court also aptly summarizes Professor Smith's conclusions (PR. 174-175):

> "The Court: Regardless of the temperature, or let's say if the liquid were at any temperature be-

tween just about freezing and its boiling point.

The Witness: No, it would have to be high enough temperature for the gelatinization of the starch.

The Court: And that is approximately what?

The Witness: Potato starch about 140°F.

• • •

The Court: • • •

Now, do I understand correctly that it is your opinion that immersion in a dextrose solution of raw potatoes does have the effect of increasing the sugar content of low sugar content potatoes but does not have the effect of decreasing the sugar content of high sugar content potatoes?

The Witness: Yes, that is essentially what I was saying.

• • •

The Court: You say that specifically with respect to a dextrose solution within the range of ¼ of 1% to 3%?

The Witness: Yes."

In the light of Professor Smith's testimony and conclusions, accepted by the District Court, it is clear that petitioner's above-quoted statement regarding them is a complete distortion.

At pages 14-15 of their petition, petitioners purport to describe the "commercial operations" of "the parties to this suit" in the preparation of French fried potatoes. However, the description which is set forth is inaccurate and incomplete, since it omits any mention of the initial hot water blanching step, in advance of the hot dextrose dip, which is included in the commercial processes employed by both petitioners and by respondent.

The District Court further found and held as follows:

"Claims 1 and 6 must also be declared invalid because the patent includes within its disclosure sugars

which the evidence shows are inoperative to produce the desired result. Among the sugars specifically mentioned in the specifications as useful are sucrose and raffinose. (Pat. Col. 3, lines 53-56). * * * [PR. 26]

* * *

* * * But defendant's evidence establishes that sucrose and raffinose are inoperative to produce the desired color change under the conditions specified in the patent. Claims 1 and 6 are therefore fatally defective under the established doctrine that claims to the exclusive use of a class, some of the members of which are inoperative in carrying out the patented process, are too broad and cannot be sustained. * * * [PR. 29]"

This finding and holding of the District Court, which is not mentioned by petitioners anywhere in their petition, is a further ground upon which Claims 1 and 6 are invalid. The evidence which the District Court considered in reaching this conclusion was discussed by it in detail in its opinon (PR. 26-29). It is more than ample to support the findings which that Court made on this issue.

Sucrose and raffinose are among the seven sugars which are specifically named in the specification as useful to produce the desired result (col. 3, ls. 53-56). However, the evidence discussed by the District Court conclusively demonstrated that sucrose and raffinose are inoperative to produce the desired result unless special measures, not taught by the patent, are taken. As Professor Smith testified, and as the District Court found, a sucrose dip may be effective to achieve the desired color change, but only under special conditions, not described or recognized in the patent, which may give a brown color as the result of hydrolysis or caramelization of the sucrose (PR. 27, 160-164, 231-232).

Not a hint of these special conditions is contained in the specification, and they can only be determined by independent experimentation. The specification simply does not teach how to succeed with sucrose or raffinose. As was shown by the evidence, both of these sugars are ineffective to produce the desired color change under the conditions specified in the patent. As the District Court correctly concluded, this renders invalid Claims 1 and 6, which, in the light of the specification defining suitable sugars (col. 3, ls. 53-56), specifically include sucrose and raffinose in the term "a sugar".

Claims to the exclusive use of a class, some of the members of which are inoperative in achieving the inventive concept, are too broad and cannot be sustained. *The Incandescent Lamp Patent, supra; Corona Co.* v. *Dovan Corp.*, 276 U. S. 358, 385 (1928); *Kalle & Co. et al.* v. *Multazo Co., Inc.*, 109 F. 2d 321, 325 (6 Cir., 1940); *American Chemical Paint Co.* v. *Firestone Steel Prod. Co.*, 117 F. 2d 927, 929-930 (6 Cir., 1941); *Libbey-Owens-Ford Glass Co.* v. *Celanese Corporation of America*, 135 F. 2d 138, 144, 145-146 (6 Cir., 1943); *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 277 (1949); *Patrol Valve Co.* v. *Robertshaw-Fulton Controls Co.*, 210 F. 2d 146, 151-152 (6 Cir., 1954); *Pemco Products, Inc.* v. *General Mills, Inc.*, 261 F. 2d 302, 304 (6 Cir., 1958). As the District Court observed, this well-established doctrine is but a special application of the requirement of 35 U.S.C. § 112 that the invention must be described so precisely as to enable any person skilled in the art to practice it without independent experimentation (PR. 29).

Furthermore, the vice of inoperativeness as to particular sugars goes far beyond the claims which specifically include these inoperative sugars. By including two inoperative sugars among seven specifically disclosed as being suit-

able (col. 3, ls. 53-56),[8] the patentee has so misled and confused the art that the entire patent becomes invalid because its specification is not a proper basis for the allowance of any claims. Thus, the failure to describe the purported invention in such full, clear, concise and exact terms as to enable one skilled in the art to avoid such inoperativeness and use the same, as required by 35 U.S.C. § 112, affects the entire patent and invalidates each of the claims. See *Tyler* v. *Boston, supra; Matheson* v. *Campbell,* 78 Fed. 910, 923 (2 Cir., 1897); and *Standard Brands, Inc.* v. *National Grain Yeast Corp., supra.* That the two inoperative sugars can be made to operate under certain special conditions which are not disclosed or taught by the patent does not in any way relieve the patent from this fatal defect. The fact remains that the patentee has failed to teach the art how to use what he considers to be his invention without further experimentation.

Thus, the District Court carefully considered all of the evidence presented by both sides which was pertinent to the issues which it decided (PR. 17-22, 26-29) and concluded that Claims 1, 6 and 7, of the patent in suit are invalid under 35 U.S.C. § 112 because of the extent of experimentation required of one skilled in the art in order to ascertain the conditions, *if there be any,* under which the process could be made to produce the results asserted for it. Although the Court of Appeals, in affirming this holding of the District Court, did not state the reason for its affirmance in this particular language, it is clear from the evi-

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[8] Actually, the patentee has included *four* inoperative sugars among the seven specifically disclosed as being suitable. Professor Smith's tests show that two other specifically mentioned sugars, maltose and lactose, and one generally included sugar, melibiose, do not produce browning (D. Ex. 12, p. 37, PR. 434; PR. 210, 231-232; D. Ex. 12, p. 35, PR. 432; PR. 208-209).

dence and the facts found by the District Court that this is the meaning and import of the language,

> "because of the extent of experimentation required of one skilled in the art in order to ascertain their 'teaching'",

of which petitioners complain. Petitioners' protestation that the ruling of the Court of Appeals "is not understood by petitioners" (Petition, p. 3) is entirely lacking in merit when considered in the light of the evidence and the facts found by the District Court.

At page 16 of their petition, petitioners state:

> "We further believe that the astounding extent of the allegedly infringing use of the patented process in these last years of the patent term also justifies this Court in granting this petition * * *."

Other statements in respect of the purported commercial success of the "patented process" appear at pages 12 and 14-15 of the petition.

This ignores the fact that there has been no ruling on the question of whether the process practiced by respondent infringes any of the claims in suit. As has been pointed out at pages 32-33, *supra*, the record shows that the process described and claimed in the patent in suit was found not to be satisfactory at a very early date, at least by 1952 (PR. 19; D. Ex. 50, PR. 490-492, 494-497; D. Ex. 49, PR. 459-461, 466-467, 470), and that the present commercial processes of petitioners as well as respondent embody major deviations from the process originally unsatisfactorily employed by petitioner, H. C. Baxter & Bro., and from anything disclosed in the patent. Under these circumstances, it is presumptuous and completely speculative to assume infringement.

As the evidence shows, after constructing its own plant in Caribou, Maine, first using only a single blancher containing dextrose solution (D. Ex. 49, PR. 466), petitioner, General Foods Corporation, altered the process by introducing an initial hot water blancher followed by a wash ahead of the sugar blancher (D. Ex. 49, PR. 466-467; D. Ex. 50, PR. 499-500), and this two-blancher process was in operation at the Caribou plant of General Foods before January 23, 1952 (D. Ex. 49, PR. 468). The function of the initial hot water blancher was to leach out the sugar and the function of the sugar blancher was to bring it up to the desired level (D. Ex. 49, PR. 468-469; D. Ex. 50, PR. 499-500). This alteration was revealed to the patentee (D. Ex. 49, PR. 472; RR. 498-499; D. Ex. 49-E, RR. 500-505; D. Ex. 50, RR. 509), and thereafter adopted by petitioner, H. C. Baxter & Bro. (D. Ex. 49, RR. 499; D. Ex. 49-F, RR. 506-507; PR. 42). As the District Court found, both petitioners have used the altered process, essentially without change, continuously since 1952 (PR. 12).

As is set forth in the stipulation (P. Ex. 8, PR. 338), respondent's process employs two hot water blanchers before the "S"-shaped flume through which the dextrose solution is made to flow, neither of which is disclosed in the patent in suit. In its normal practice, respondent does not rely upon the dextrose dip to adjust the sugar content of the potatoes or to produce uniformity of color, but uses the dextrose solution in order to restore the natural sugars which have been leached out of the potatoes in the two hot water blanchers (PR. 138-139).

Thus, the commercial history of the patent in suit lends no support to petitioners' statements as to the purported commercial success of the "patented process" but rather points in the opposite direction. Furthermore, other factors which are completely unrelated to the so-called "dex-

trose process" have contributed to the present importance and success of frozen French fried potatoes, such as, for example, the increasing availability of means for storing frozen foods. As Professor Smith testified, in 1945, following World War II, the frozen food industry was in its infancy and there were very few home freezers for the holding of frozen foods in individual homes (PR. 212).

Throughout their petition, petitioners endeavor to offer an explanation of what purportedly occurs when potato strips are immersed in a hot dextrose solution (see, for example, pp. 10, 13, 14, 15). However, the explanation offered by petitioners is a theoretical dissertation which bears no relation whatsoever to the evidence in the record. It is merely a hypothetical discussion of what the process described in the patent is *supposed* to accomplish, as distinguished from what it *actually* does accomplish, and petitioners carefully refrain from making any reference to what actually occurs as demonstrated by the evidence.

At page 15 of their petition, petitioners state:

> "The patent statutes nowhere require any statement of a theory to explain the *why* of a new process; they require a clear prescription of the *how*. That *how* is clearly stated in the patent in suit, but the courts below found the patent invalid because the *why* seemed to have been stated incorrectly. * * *"

An examination of the opinions of both of the courts below reveals that there is no merit whatsoever to petitioners' argument that "the courts below found the patent invalid because the *why* seemed to have been stated incorrectly". It is plain from such opinions that *actuality, not theory or supposition,* was the basis for the decisions of the courts below.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Dated: New York, New York, March 22, 1966.

Respectfully submitted,

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